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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,174	08/29/2000	Robert A. Cordery	F-189	9744

919 7590 11/18/2003

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EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/18/2003

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/650,174
Filing Date: August 29, 2000
Appellant(s): CORDERY ET AL.

MAILED

Paper No. 17

NOV 18 2003

GROUP 3600

Mr. Brian A. Lemm
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06 October 2003.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is substantially correct but does not fully comply with rule 37 CFR 192(c)(5) since the summary does not refer to the specification by page and line number, and to the drawing, if any, by reference characters

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant indicates that claims 35 and 36 form Group I and, therefore, stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,868,877	Fischer	9-1989
5,771,289	Kuzma	6-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Claims 35 and 36 are rejected under 35 U.S.C: 103(a) as being unpatentable over Fischer, U.S. Patent No. 4,868,877 in view of Kuzma, U.S. Patent No. 5,771,289.

As per **Claim 35**, Fischer discloses a method for validating a signed digital message, comprising the steps of receiving a signed digital message from a sender and validating the signed digital message using a public key of the sender (Col. 3, lines 22-35; Col. 6, lines 34-45; Col. 7, lines 5-30 and 60-67). Fischer, however, fails to explicitly disclose providing a register having funds stored therein, determining if sufficient funds are present in the register for validating the message and deducting funds from the register for validating the message. Kuzma discloses a method and apparatus for transmitting electronic data using attached electronic credits to pay for the transmission. Kuzma teaches the use of a register having funds stored therein, determining if sufficient funds are available in the register for validating a message, and deducting funds from the register for validating the message (Col. 5, lines 23-44; Col. 5 line 63-Col. 6 line 5; Col. 7, lines 40-45; Col. 7 line 63-Col. 8 line 9). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fischer and include determining if sufficient funds are available for processing the validation and charging the consumer or deducting funds. The motivation would be to guarantee payment to the entity providing the service of validating the message (see Kuzma, Col. 8, lines 59-65).

As per **Claim 36**, Fischer further discloses receiving with the signed digital message a certificate of the sender, the certificate being signed using a private key of the certificate authority (Col. 3, lines 21-34, Col. 7, lines 5-29 and 60-67), validating the certificate using a public key of the certificate authority (Col. 7, lines 30-67), and extracting the public key of the sender from the certificate for use in validating the signed digital message (Col. 3, lines 21-34; Col. 6, lines 34-43; Col. 7, lines 5-30) which is a process well known in the encryption and digital signature arts.

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(11) Response to Argument

Applicant first asserts that while Fischer discloses the use of certificates for providing security functions, there is no disclosure, teaching or suggestion in Fischer of providing payment to the certificate authority for processing, i.e., validating the signed digital message. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing payment to the certificate authority for processing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims merely recite that funds are deducted from a register for validating the message. There is no suggestion that the funds are used as payment to a certificate authority.

Applicant further asserts that there is no disclosure, teaching or suggestion is Kuzma of signed digital messages or validating a signed digital message. Examiner agrees with this assertion in part since the message in Kuzma is not signed, however, examiner has not relied upon Kuzma for this specific teaching, but rather the reference to Fischer teaches this aspect in accordance with the rejection above. Kuzma does, however, disclose a system wherein an encoded electronic stamp is affixed to an encrypted electronic message and further wherein a unique code is inserted into the electronic stamp for authenticating the electronic stamp. The electronic message is then forwarded to a post office wherein the electronic post office checks the electronic stamp or authenticity prior to transmitting the electronic message to its destination. An authenticator at the post office examines the authentication code in the electronic stamp to ensure that the electronic stamp is legitimate, i.e., not a forgery and not been previously used or canceled. Thus, Kuzma at least discloses validating an electronic message by authenticating the electronic stamp (Col. 5 line 30-Col. 6 line 5). Kuzma further discloses the concept of using a register having funds stored therein to pay for services performed such as the transmission and validation of an electronic message (Col. 7, lines 37-49).

Applicant further submits that it would not have been obvious to combine the teachings of Fischer and Kuzma to arrive at the present invention and further notes that the combination would

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simply teach a method and system to pay a transmission service for the electronic transmission of the digital message created and signed by the trusted authority. In response to this argument by the applicant, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

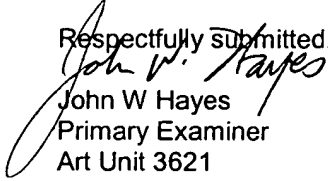
In this case, Fischer discloses services being performed such as validating signed digital messages received by a sender using the public key of the sender as is notoriously well known in the art. Fischer, however, does not disclose using a register with funds stored therein and deducting funds from the register to pay for these services. Examiner has relied upon Kuzma to provide the missing features of Fischer. Kuzma discloses a method and apparatus for transmitting electronic data using attached electronic credits to pay for the transmission and authentication of the stamp. Kuzma explicitly teaches the use of a register having funds stored therein, determining if sufficient funds are available in the register for transmitting and validating a message, and deducting funds from the register for transmitting and validating the message. Thus, Kuzma teaches the concept of using a register having funds stored therein to pay for services performed such as validating a message to ensure legitimacy. Examiner submits that there is motivation for combining these references since both references teach the feature of performing a service to customers and Kuzma further teaches a method of using a register having funds therein to pay for the service. One would have been motivated to combine these references in order to guarantee payment to the entity providing the service and to pay for use of

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the services equipment, regardless of the type of service being conducted (see Kuzma, Col. 8, lines 59-65).


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


John W Hayes
Primary Examiner
Art Unit 3621

November 17, 2003

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